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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/738,235	12/15/2000	Gregory Eydelman	260/147	2741

7590 12/16/2002  
Brandon N. Sklar  
The law Office of Brandon N. Sklar  
20 Howard Avenue  
Valhalla, NY 10595

EXAMINER

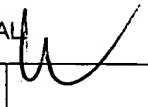
VARGAS, DIXOMARA

ART UNIT PAPER NUMBER

2862

DATE MAILED: 12/16/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/738,235	<b>Applicant(s)</b> EYDELMAN ET AL 
	<b>Examiner</b> Dixomara Vargas	<b>Art Unit</b> 2862

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 23 September 2002.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-18, 22-26, 30-36, 61-70 and 86 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18, 22-26, 30-36, 61-70 and 86 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All   b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### *Double Patenting*

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-18, 22-26, 30-36, 61-70 and 86 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-57 of copending Application No. # 09/738233. Although the conflicting claims are not identical, they are not patentably distinct from each other because for example, claim 1 recites "the inner and outer conductors defining a region for receiving a body part and being inductively couple during

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operation” wherein it is clearly stated that the inner and outer conductor are inductively connected which is equivalent to an electrical connection as recited on ‘233 application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### *Response to Arguments*

3. Applicant's arguments filed September 23, 2002 have been fully considered but they are not persuasive. In regards to the double patenting rejection, applicant argues, on pages 3-7, that “in contrast to the claims of the present application, the claims of ‘233 application required that the inner conductor be electrically connected to the outer conductor”. The examiner disagrees since claim 1 recites “the inner and outer conductors defining a region for receiving a body part and being inductively couple during operation” wherein it is clearly stated that the inner and outer conductor are inductively connected which is equivalent to an electrical connection as recited on ‘233 application. If applicant means that the inner conductor is connected to the other end of the inner conductor and the outer conductor being connected to the other end of the outer conductor, the examiner believes that claim as presented at the time does not clearly state said connection. In contrast, the claim states only a connection of the inner and outer conductors which is clearly the scope of the invention of ‘233 application since it is not specified that said connections are between the inner and outer conductors or between the inner conductor's ends or the outer conductor's ends.

4. In regards to the restriction requirement, applicant argues that said requirement is improper since groups I and II recites the same subject matter. The examiner disagrees since group II is directed to the NMR system containing the antenna. However, group I is directed

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specifically to the antenna construction. The antenna and its components are considered a different scope of the invention from the system and its relationship with the antenna itself. For the reasons stated above, a different search is required and the restriction requirement is held proper.

5. In regards to the election of species requirement, applicant argues that said requirement is improper since groups A-F recite the same subject matter. The examiner disagrees since sub groups A-F from group I discloses different embodiments of the antenna since each independent group requires the following different components not required for the others:

- a. Subgroup IA discloses an antenna for receiving which comprises inner and outer conductors.
- b. Subgroup IB discloses an antenna for receiving which comprises second winding shielding a first winding.
- c. Subgroup IC discloses detecting means, receiving means and shielding means.
- d. Subgroup ID disclosing three coaxial cable units tuned to the same frequency.
- e. Subgroup IE disclosing coaxial cables supported by a support on a plane.
- f. Subgroup IF disclosing an antenna for transmitting, which comprises inner and outer conductors.

For the reasons stated above, every subgroup or different embodiment requires a different search for each different feature claimed and the election of species is held proper.

### *Conclusion*

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

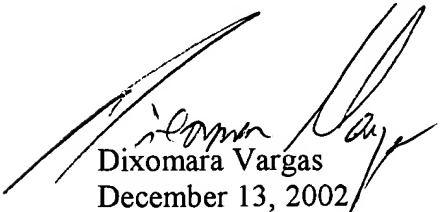
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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dixomara Vargas whose telephone number is (703) 305-5705. The examiner can normally be reached on 8:00 am. to 4:30 pm..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Lefkowitz can be reached on (703) 305-4816. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-3432 for regular communications and (703) 305-3432 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-0956.



Dixomara Vargas  
December 13, 2002



EDWARD LEFKOWITZ  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2800